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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,996	11/09/2001	Peter Trefonas III	50964	3653

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EXAMINER
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GUILL, RUSSELL L

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/035,996

Applicant(s)

TREFONAS, PETER

Examiner

Russell L. Guill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1 – 10 have been examined. Claims 1 – 10 have been rejected.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 4, claim 4 recites, “wherein said simulation outputs a simulation result”. The phrase “said simulation” appears to lack sufficient antecedent basis. For the purpose of claim interpretation, the phrase, “said simulation” is interpreted as “said simulation engine”. Correction or amendment is required.
4. Claims 1, 4, 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite, “simulation engine”. The phrase “simulation engine” does not allow one to determine the metes and bounds of the claim. For the purpose of claim interpretation, the phrase, “simulation engine” is interpreted as “any

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combination of hardware and/or software that takes a desired result as input and outputs at least one parameter setting for operating equipment to achieve a desired result". Correction or amendment is required.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, claim 1 recites, "a consumable knowledge base". The phrase "consumable knowledge base" does not allow one to determine the metes and bounds of the claim. For the purpose of claim interpretation, the phrase, "consumable knowledge base" is interpreted as "any combination of hardware and/or software that takes as input at least one parameter setting for operating equipment to achieve a desired result, and outputs a consumable selection for use in the equipment to achieve a desired result". Correction or amendment is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 – 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention

appears to be directed to an abstract idea, and does not appear to produce a concrete and tangible result.

8. Claims 6 – 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention appears to be directed to an abstract idea, and does not appear to produce a concrete and tangible result.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

10. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

10.1. XeroxReferenceGuide appears to teach a simulation engine, said simulation engine receiving a desired result and outputting at least one parameter setting for operating the equipment to achieve the desired

result (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).

10.1.1. Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).; it is inherent in the device that a simulation engine receives the desired result of “auto paper” and outputs image size settings as output parameter settings in order to operate the equipment to achieve the desired result.

10.2. XeroxReferenceGuide appears to teach a consumable knowledge base, said consumable knowledge base receiving said at least one parameter setting and outputting a consumable selection for use in said equipment to achieve the desired result (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).

10.2.1. Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).; it is inherent in the device that a consumable knowledge base receives the image size settings and outputs a selected paper size for use in the equipment to achieve the desired result.

11. Claim 2 is rejected under 35 U.S.C. 102(a) as being anticipated by XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

**11.1.** Claim 2 is a dependent claim of claim 1, and thereby inherits all of the rejected limitations of claim 1.

**11.2.** XeroxReferenceGuide appears to teach that the system is in communications with the equipment and the system communicates the at least one parameter setting to the equipment for setting the equipment according to the at least one parameter **(page 3-2, element label that starts “Touch the Screen . . . ”)**.

**11.2.1.** Regarding **(page 3-2, element label that starts “Touch the Screen . . . ”)**; it is inherent in the construction of the equipment that the system communicates the at least one parameter setting to the equipment for setting the equipment according to the at least one parameter.

**12.** Claim 4 is rejected under 35 U.S.C. 102(a) as being anticipated by XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

**12.1.** Claim 4 is a dependent claim of claim 1, and thereby inherits all of the rejected limitations of claim 1.

**12.2.** XeroxReferenceGuide appears to teach that the simulation outputs a simulation result **(page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . . ”)**.

**12.2.1.** Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”); it is inherent in the device that a simulation engine receives the desired result of “auto paper” and outputs image size settings as a simulation result.

**13.** Claim 6 is rejected under 35 U.S.C. 102(a) as being anticipated by XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

**13.1.** XeroxReferenceGuide appears to teach receiving the desired result into a simulation engine (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).

**13.1.1.** Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”); it is inherent in the device that a simulation engine receives the desired result of “auto paper” and outputs image size settings as output parameter settings in order to operate the equipment to achieve the desired result.

**13.2.** XeroxReferenceGuide appears to teach outputting from the simulation engine at least one parameter setting for operating the equipment to achieve the desired result (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).

**13.2.1.** Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”); it is inherent in the device that a simulation engine receives the desired result of “auto paper” and outputs image size settings as output parameter settings in order to operate the equipment to achieve the desired result.

**13.3.** XeroxReferenceGuide appears to teach outputting a consumable selection for use in the equipment to achieve the desired result (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”).

**13.3.1.** Regarding (page 4-9, paragraphs 2, 3, and 4. Paragraph 2 starts with “When Auto Paper . . .”); the selected paper is the consumable.

**14.** Claim 7 is rejected under 35 U.S.C. 102(a) as being anticipated by XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

**14.1.** Claim 7 is a dependent claim of claim 6, and thereby inherits all of the rejected limitations of claim 6.

**14.2.** XeroxReferenceGuide appears to teach setting the equipment according to the at least one parameter (page 3-2, element label that starts “Touch the Screen . . . “).

- 14.2.1.** Regarding (page 3-2, element label that starts "Touch the Screen . . . "); it is inherent in the construction of the equipment that the equipment is set according to the at least one parameter setting.

***Claim Rejections - 35 USC § 103***

- 15.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 16.** Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over XeroxReferenceGuide ("Xerox Document Centre Reference Guide", February 2000, Xerox Corporation).

- 16.1.** Claim 3 is a dependent claim of claim 1, and thereby inherits all of the rejected limitations of claim 1.

- 16.2.** XeroxReferenceGuide appears to teach a configuration file for storing the desired result (page 4-35, section labeled "Stored Programming").

- 16.2.1.** Regarding (page 4-35, section labeled “Stored Programming”); it is obvious that the results are stored to a configuration file.
- 16.3.** XeroxReferenceGuide does not specifically teach a configuration file for storing the desired result, a reference to the equipment, the at least one parameter setting, and the consumable selection.
- 16.4.** It would have been obvious to one of ordinary skill in the art at the time of invention to store a reference to the equipment, the at least one parameter setting, and the consumable selection.
- 16.5.** The motivation would have been obvious because the additional elements would have been needed in order to completely restore the state of the equipment settings for operation.
- 16.6.** Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to produce the invention of claim 3.
- 17.** Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation) in view of Smith (U.S. Patent 6,601,159 B1).

**17.1.** Claim 5 is a dependent claim of claim 1, and thereby inherits all of the rejected limitations of claim 1.

**17.2.** The art of XeroxReferenceGuide is directed to the features and functions of a Xerox photocopier machine **(Title)**.

**17.3.** The art of Smith is directed to an information support system for a photocopier machine **(Title of patent)**.

**17.4.** XeroxReferenceGuide does not specifically teach **a process step configurator, the process step configurator receiving the desired result, the at least one parameter setting and the consumable selection and outputting a step-by-step process for achieving the desired result.**

**17.5.** Smith appears to teach a process step configurator **(column 8, lines 45 -55)**, the process step configurator receiving the desired result **(column 6, lines 45 - 47; column 9, lines 56 - 60)**, the at least one parameter setting **(column 6, lines 45 - 47; column 9, lines 56 - 60)** and the consumable selection **(column 6, lines 45 - 47; column 9, lines 56 - 60)** and outputting a step-by-step process for achieving the desired result **(column 8, lines 45 -55)**.

**17.6.** The art of XeroxReferenceGuide and the art of Smith are analogous art because they are both directed to the art of photocopier functions.

**17.7.** The motivation to use the art of Smith with the art of

XeroxReferenceGuide would have been obvious because of the benefits recited in Smith such as training new users (column 3, lines 35 – 40), and reducing cost (column 3, lines 51 – 56).

**17.8.** Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to use the art of Smith with the art of XeroxReferenceGuide to produce the claimed invention.

**18.** Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over XeroxReferenceGuide (“Xerox Document Centre Reference Guide”, February 2000, Xerox Corporation).

**18.1.** Claim 8 is a dependent claim of claim 6, and thereby inherits all of the rejected limitations of claim 6.

**18.2.** XeroxReferenceGuide appears to teach storing the desired result to a configuration file (page 4-35, section labeled “Stored Programming”).

**18.2.1.** Regarding (page 4-35, section labeled “Stored Programming”); it is obvious that the results are stored to a configuration file.

**18.3.** XeroxReferenceGuide does not specifically teach storing the desired result, **a reference to the equipment, the at least one parameter setting, and the consumable selection** to a configuration file.

**18.4.** It would have been obvious to one of ordinary skill in the art at the time of invention to store **a reference to the equipment, the at least one parameter setting, and the consumable selection** to a configuration file.

**18.5.** The motivation would have been obvious because the additional elements would have been needed in order to completely restore the state of the equipment settings for operation.

**18.6.** Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to produce the invention of claim 8.

**19.** Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over XeroxReferenceGuide ("Xerox Document Centre Reference Guide", February 2000, Xerox Corporation) in view of Smith (U.S. Patent 6,601,159 B1).

**19.1.** Claim 10 is a dependent claim of claim 1, and thereby inherits all of the rejected limitations of claim 1.

- 19.2.** The art of XeroxReferenceGuide is directed to the features and functions of a Xerox photocopier machine **(Title)**.
- 19.3.** The art of Smith is directed to an information support system for a photocopier machine **(Title of patent)**.
- 19.4.** XeroxReferenceGuide does not specifically teach **outputting a step-by-step process for achieving the desired result based on the desired result, the at least one parameter setting and the consumable selection.**
- 19.5.** Smith appears to teach outputting a step-by-step process for achieving the desired result **(column 8, lines 45 - 55)** based on the desired result **(column 6, lines 45 - 47; column 9, lines 56 - 60)**, the at least one parameter setting **(column 6, lines 45 - 47; column 9, lines 56 - 60)** and the consumable selection **(column 6, lines 45 - 47; column 9, lines 56 - 60)**.
- 19.6.** The art of XeroxReferenceGuide and the art of Smith are analogous art because they are both directed to the art of photocopier functions.
- 19.7.** The motivation to use the art of Smith with the art of XeroxReferenceGuide would have been obvious because of the benefits recited in Smith such as training new users **(column 3, lines 35 - 40)**, and reducing cost **(column 3, lines 51 - 56)**.

**19.8.** Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to use the art of Smith with the art of XeroxReferenceGuide to produce the claimed invention.

### ***Conclusion***

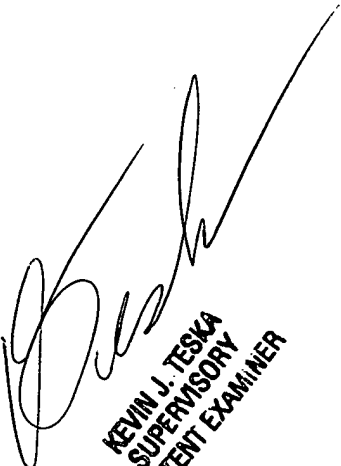
**20.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell L. Guill whose telephone number is 571-272-7955. The examiner can normally be reached on Monday – Friday 9:00 AM – 5:30 PM.

**21.** If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 571-272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist: 571-272-2100.

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**22.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RG



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